

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)	
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Waterhouse, Peter Michael et al.)	Group Art Unit: 1635
)	
Application No.: 09/287,632)	Examiner: ZARA, JANE J
)	
Filed: April 7, 1999)	Confirmation No.: 6526
)	
For: Methods and Means for Obtaining)	
Modified Phenotypes)	
)	
)	

PETITION UNDER 37 C.F.R. § 1.181

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with M.P.E.P. § 2720, this petition under 37 C.F.R. § 1.181 is filed to invoke the supervision of the Director and request reconsideration of the determination of patent term extension that was printed on the Notice of Allowance and Issue Fee(s) Due in the above captioned application. This paper is timely filed on November 26, 2012, because the date that is two months after the September 25, 2012 date on which the Notice of Allowance was mailed fell on a Sunday. 37 C.F.R. §§ 1.7 & 1.181(f).

The Determination of Patent Term Extension under 35 U.S.C. § 154(b) provided with the Notice of Allowance and Issue Fee(s) Due indicates that the extension is 0 days. For the reasons stated below, the patent will actually be eligible for at least 1006 days of term extension. Reconsideration and appropriate correction of the determination of patent term extension is respectfully requested.

Application No.: 09/287,632 was filed April 7, 1999. Therefore, the provisions of 35 U.S.C. § 154 in effect between June 8, 1995 and May 28, 2000 are applicable to this application.

35 U.S.C. § 154(b) provides in relevant part as follows:

(b) TERM EXTENSION.—

...

(2) EXTENSION FOR APPELLATE REVIEW. —If the issue of a patent is delayed due to appellate review by the Board of Patent Appeals and Interferences or by a Federal court and the patent is issued pursuant to a decision in the review reversing an adverse determination of patentability, the term of the patent shall be extended for a period of time but in no case more than 5 years. A patent shall not be eligible for extension under this paragraph if it is subject to a terminal disclaimer due to the issue of another patent claiming subject matter that is not patentably distinct from that under appellate review.

(3) LIMITATIONS.—The period of extension referred to in paragraph (2)—

(A) shall include any period beginning on the date on which an appeal is filed under section 134 or 141 of this title, or on which an action is commenced under section 145 of this title, and ending on the date of a final decision in favor of the applicant;

(B) shall be reduced by any time attributable to appellate review before the expiration of 3 years from the filing date of the application for patent; and

(C) shall be reduced for the period of time during which the applicant for patent did not act with due diligence, as determined by the Commissioner.

(4) LENGTH OF EXTENSION.—The total duration of all extensions of a patent under this subsection shall not exceed 5 years.

The application was delayed due to appellate review by the Board of Patent Appeals and Interferences. The dates relevant to the delay due to appellate review by the Board of Patent Appeals and Interferences are as follows:

Notice of Appeal under 35 U.S.C. § 134 and Amendment canceling claims to reduce issues on appeal.	November 5, 2009
Official Action (entering Amendment and making rejection final)	December 8, 2009
Appeal Brief pursuant to 37 C.F.R. § 41.37 with a renewed Notice of Appeal	April 8, 2010
Examiner's Answer pursuant to 37 C.F.R. § 41.39	July 7, 2010
Reply Brief pursuant to 37 C.F.R. § 41.41	September 7, 2010
Oral Hearing pursuant to 37 C.F.R. § 41.47	January 12, 2012
Decision of the Board of Patent Appeals and Interferences pursuant to 37 C.F.R. § 41.50 (reversing 3 of 4 grounds of rejection)	March 30, 2012
Request for Rehearing pursuant to 37 C.F.R. § 41.52 (of the fourth ground of rejection)	May 30, 2012
Decision on Request for Rehearing - GRANTED	August 6, 2012
Notice of Allowance	September 25, 2012

Following grant of Applicants' Request for Rehearing, a Notice of Allowance was issued. Therefore, the patent is being issued as a direct result of a decision of the Board reversing an adverse determination as to patentability. The patent is not subject to a terminal disclaimer due to the issue of another patent claiming subject matter that is not patentably distinct from that under appellate review.

Accordingly, the patent is eligible for extension for the duration of the period beginning on the date on which an appeal was filed under 35 U.S.C. § 134 (*i.e.*, November 5, 2009) and ending on the date of the final decision in favor of the applicant (*i.e.*, August 6, 2012) pursuant to 35 U.S.C. § 154(b)(2) in effect at the time the application was filed.

The period beginning on the day that the Notice of Appeal was first filed on November 5, 2009 and ending on the date of the final decision granting Applicants' Request for Rehearing on August 6, 2012 is 1006 days.

It is noted that between the date that the Notice of Appeal was first filed and Applicants Appeal Brief was filed, the Examiner issued an Official Action entering Applicants' Amendment canceling claims and setting a new period for taking action. Applicants filed a renewed Notice of Appeal on April 8, 2010 together with Applicants' Appeal Brief. The period beginning on April 8, 2010 and ending on August 6, 2012 comprises 852 days. This would be the minimum delay for which Applicants are entitled to extension of the patent term.

37 C.F.R. § 1.701(d) states:

The period of delay set forth in paragraph (c)(3) shall be reduced by (1) Any time during the period of appellate review that occurred before three years from the filing of the first national application for patent presented for examination; and (2) Any time during the period of appellate review, as determined by the Director, during which the applicant for patent did not act with due diligence. In determining the due diligence of an applicant, the Director may examine the facts and circumstances of the applicant's actions during the period of appellate review to determine whether the applicant exhibited that degree of timeliness as may reasonably be expected from, and which is ordinarily exercised by, a person during a period of appellate review.

The whole period of delay occurred after the application had been pending for more than three years and it is believed that Applicants acted with due diligence during the period

of appellate review. During the period beginning with the filing of a Notice of Appeal on November 5, 2009 and ending with the Decision granting Applicants' Request for Reconsideration on August 6, 2012, Applicants required only a one month extension to April 8, 2010 of the period set by the Examiner to respond to the Official Action dated December 8, 2009. During the period from April 8, 2010 to August 6, 2012, Applicants filed all papers without delay or extension of the period for response.

The total period of delay due to appellate review from the original filing of the Notice of Appeal to the final Decision which resulted in allowance is 1006 days. In accordance with 35 U.S.C. § 154(b)(2), the term of the patent should be extended by 1006 days. If the Director determines that extension by one month to April 8, 2010 of the period for reply set by the Official Action dated December 8, 2009 constitutes a lack of diligence, then the period of extension would be reduced to no less than 975 days. At the very least, the period of delay calculated from the date on which the Notice of Appeal was renewed and an Appeal Brief was filed on April 8, 2010 until the final Decision of the Board is 852 days and this is the minimum extension of patent term to which Applicants are entitled.

Reconsideration and appropriate correction of the determination of patent term extension is respectfully requested.

In accordance with MPEP § 2720 and 37 C.F.R. § 1.181, it does not appear that a fee is required for this petition. If any fee is required by this paper, please charge such fee to deposit account 02-4800.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: November 26, 2012

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